



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Takashi IGARASHI et al.

Group Art Unit: 3727

Application No.: 10/611,918

Examiner: H. SHAKERI

Filed: July 3, 2003

Docket No.: 108833.01

For: LENS MACHINING APPARATUS, LENS MACHINING METHOD, AND LENS MEASUREMENT METHOD

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This request is being filed with a Notice of Appeal. Review of the November 18, 2009 Final Rejection is requested for the reasons set forth in the attached five or fewer sheets.

Should any questions arise regarding this submission, or the Review Panel believe that anything further would be desirable in order to place this application in even better condition for allowance, the Review Panel is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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Date: February 17, 2010

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REMARKS

Claim 5 is pending in this application.

The Office Action objects to the drawings. The objection is respectfully traversed.

The Final Rejection errs when it alleges that the drawings fail to show each and every feature of the invention specified in the claims. Applicants submit that the drawings depict each and every feature recited in the claims as detailed below.

One of ordinary skill in the art would understand that, to the extent that the features "turning speed of the revolving machining tool," "turning speed of the held plastic lens," and "a number of revolution of the plastic lens" need to be depicted, the chart in Fig. 24 provides the necessary illustration. The ongoing objection in the Office Action is, therefore, without basis. Withdrawal of the objection is respectfully requested.

The Office Action rejects claim 5 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. This rejection is respectfully traversed.

The Final Rejection errs when it asserts that "claim 5 has been amended to read over prior art applied, and claim recites features not clearly defined by the specification as originally field, [sic] and as was indicated in the Office Action, the deficiencies appears [sic] to be of clarity and not of enablement. Applicant's explanation of how columns and rows meet the recited features and/or how column and rows may be defined, does not overcome the deficiencies." See Final Rejection page 6, lines 11-16. Though Applicants will discuss each feature indicated in the rejection, one of ordinary skill in the art would understand the metes and bounds of the claimed subject matter based on Applicants' claims and specification, as filed.

The test for compliance with 35 U.S.C. §112, second paragraph is whether one skilled in the art would understand the bounds of the claims when read in light of the specification. *Miles Lab., Inc. v. Shandon Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993), *cert. denied*, 510 U.S. 1100 (1994). If the claims, read in light of the specification,

reasonably apprise those skilled in the art of the scope of the invention, §112 demands no more. *See also, In re Merat*, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975) (stating that the question under §112, second paragraph is whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct. *See also, In re Warmerdam*, 33 F3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

Regarding the Office Action's rejection, "a number of revolutions of plastic lens is calculated based on...material of the plastic lenses, the edge thickness...the kind of machining...the turning speed" would be understood by one of ordinary skill in the art based on, for example, Fig. 24 and Applicants' specification page 67, line 1 - page 70, line 2, for reasons similar to those explained above regarding the objections to Fig. 24.

Further, the Office Action's remarks regarding columns and rows, alleging that the claims are indefinite based on the specification disclosing "columns" and the claims claiming "rows" is without basis. The Office Action gives no reason for regarding claim 5 as indefinite based on "columns" and "rows." The term "rows" is just as clear and definite as the term "columns." Further, to the extent that the specification discloses columns, instead of rows, the application supports both embodiments: columns and rows, and therefore supports rows. Fig. 24 clearly supports the recited rows, as explained above. Applicants may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. *See In re Swinehart*, 439, F.2d 210, 160 USPQ 226 (CCPA 1971). Withdrawal of the rejection is respectfully requested.

The Office Action rejects claim 5 under 35 U.S.C. §103(a) over JP-A-64-016346 to Satoru, and rejects claim 5 under 35 U.S.C. §103(a) over Satoru in view of U.S. Patent No. 5,053,971 to Wood. These rejections are respectfully traversed.

The Final Rejection errs when it asserts "one of ordinary skill in the art would have known that desired finish and/or rough machining would directly depend on the thickness of the work, or the amount to be abraded, therefore it would have been obvious to one of ordinary skill in the art to modify the Table to further include the thickness of work in addition to the material to be cut in achieving the desired result, *e.g.*, in abrading a plastic lens commonly used." See Final Rejection, page 4, lines 21 - page 5, line 6. Further, the Office Action errs where it alleges "it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of JP '346 with additional variables, *e.g.*, thickness as taught by Wood to adopt the method for operations like chamfering, grooving, etc." Satoru does not support the Office Action's assertion that a skilled artisan would have known that the desired machining would depend on the thickness of the work. Further, Wood merely discloses "verify[ing] that there will be sufficient thickness at the peripheral edge of the cut lens to permit beveling." Thus, the Final Rejection errs in the assertion that a person of ordinary skill in the art would have either (1) modified Satoru or (2) modified Satoru in view of Wood to obtain the features recited in claim 5 without determining the level of ordinary skill in the art in violation of MPEP §2141.03.

This application claims that a number of revolutions of the plastic lens is calculated based on a type of material of the plastic lens, an edge thickness of the plastic lens being machined, a kind of machining and the turning speed of the plastic lens.

The Office Action acknowledges that Satoru does not disclose the thickness of the lens. The Office Action asserts that "one of ordinary skill in the art would have known that desired finish and/or rough machining would directly depend on the thickness of the work."

This application discloses that a number of revolutions of the plastic lens is calculated based on the edge thickness (Fig. 25). The Office Action's assertion that a skilled artisan would have known that desired machining would depend on the thickness of the work is not supported by any disclosure in Satoru. Further, the Office Action only relates "desired

machining" to the edge thickness. The Office Action does not assert that a number of revolutions of the plastic lens is calculated based on the edge thickness. Thus, even in view of the Office Action's unsupported assertion about what the skilled artisan would have known, Satoru would not have suggested that a number of revolutions of the plastic lens is calculated based on the edge thickness, as recited in claim 5.

The Office Action also relies on Wood as supplying the edge thickness feature. Wood only discloses, however, "verify[ing] that there will be sufficient thickness at the peripheral edge of the cut lens to permit beveling." Verifying that there will be sufficient thickness cannot reasonably be considered to correspond to calculating a number of revolutions of the plastic lens, as recited in claim 5. Thus, Wood does not supply the subject matter missing in Satoru.

"The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). The Examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand. *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984). This standard is not met here. In rejecting Applicants' claim, the Office Action alleges that the features recited in claim 5 would have been obvious to one of ordinary skill in the art at the time of invention, without any factual support. Thus, the rejection is improper.

In view of the above, Satoru and Wood, individually, or in combination, would not have suggested the combination of features recited in claim 5.

Accordingly, reconsideration and withdrawal of the obviousness rejections of claim 5 are respectfully requested.

Applicants made essentially the above arguments in a previous Request for Reconsideration. In response to those arguments this Office Action alleges that "because of the indefiniteness, it is unclear what the scope of the invention is, and the features of the claimed invention as best understood are met by modified Satoru." Applicants are very concerned with the prosecution of this application to date, as discussed below. This application was filed on July 3, 2003. A first Office Action was mailed on April 15, 2004. That Office Action was the first of now nine Office Actions in this application including at one point indicating that the claims, as written, were allowed. Applicants are concerned about the piecemeal prosecution of this application to date. There is further concern regarding the Examiner's assertions, at this point in examination of this application, that he does not understand the subject matter of the pending claims, or does not understand how the features recited in the claims find support and definiteness from Applicants' disclosure, as originally filed. The Office Action, as noted above, fails to specifically address the arguments made regarding the prior art rejections in Applicants' previous request.

In the Response to Argument section, it is unclear what feature the rejection under 35 U.S.C. §112, second paragraph, is directed. The response indicates that the claim is unclear because it allegedly "has been amended to read over prior art applied," which does not render the claim indefinite.

The Office Action clearly must rely on impermissible hindsight reasoning by using claim 5 as a roadmap to reverse engineer Satoru and/or Wood to obtain the claimed features, because the Office Action cites no support for the rejection except to allege that "it would have been obvious to one of skill in the art."